

REMARKS

The outstanding final Office Action mailed December 19, 2003 (Paper No. 1203) has been carefully considered. Applicant notes that the lower right-hand margin of the Office Action Summary indicates that the Office Action is paper no. 1203. Applicant believes that the Office Action is paper no. 15. Nevertheless, Applicant will refer to the present Office Action as paper no. 1203.

In response thereto, Applicant submits herewith a Request for Continued Examination under 37 CFR 1.114 and the accompanying amendments and remarks. Please accept the Request for Continued Examination and enter the foregoing amendments in which claims 16 and 37 are amended. Claims 40 - 77 have been added. Claims 1-77 are now pending in the present application. The subject matter of amended claims 16, 37 and new claims 40 - 77 can be found in at least FIGs. 3-5, 7, 9, and 10 and the related detailed description. Thus, Applicant submits no new matter has been added to the application.

Applicant notes that the amendment filed on April 3, 2003 failed to correctly mark all claim amendments submitted therein. Specifically, claims 9, 10, and 15 were amended to change respective claim dependency. More specifically, claim 9 was amended to depend from claim 3. Claim 9 depended from claim 8 when originally filed. Claim 10 was amended to depend from claim 4. Claim 10 depended from claim 1 when originally filed. Claim 15 was amended to depend from claim 9. Claim 15 depended from claim 1 when originally filed.

In response to paragraph 1 of paper no. 1203, Applicant has amended independent claim 16.

In response to paragraphs 3, and 5 - 7 of paper no. 1203, Applicant requests the Office to reconsider the rejection of claims 1 - 39 in light of the following remarks.

In view of the foregoing amendments and the following remarks, reconsideration and allowance of the present application and claims 1-77 are respectfully requested.

I. Preliminary Matters

A. Examiner Interview

Applicant thanks the Examiner for agreeing to teleconference with Applicant's undersigned attorney on the afternoon of February 11, 2004 to discuss Applicant's

independent claims and review structures illustrated in Applicant's odd numbered figures. Although agreement was not be reached regarding the patentability of Applicant's claims, the Examiner indicated that recitation of physical structure(s) and structural relationships would be helpful. In response, Applicant has added new claims 40 – 77. These new claims recite additional structure and structural relationships also not found in *Minowa '408*, *Minowa '161*, and *Minowa '918*.

B. Office Fails to Acknowledge Applicant's Definition of "Channel"

Applicant's independent claims 1, 16, 20, 26, and 37 recite a "channel." Applicant has defined "channel" as an elongated gutter, groove, or furrow (see Applicant's Response, mailed November 8, 2002, Paper No. 4, page 11, last full paragraph). Applicant respectfully reiterates that a "channel" (*i.e.*, a structure) that protrudes from a housing as claimed in Applicant's scanner assembly and methods is not found in *Minowa '408*. For at least the reason that *Minowa '408* does not disclose, teach, or suggest Applicant's claimed channel, Applicant's claimed assemblies and methods are allowable over *Minowa '408*.

C. Office's Interpretation of "Protrude" is Not in Accordance with its Ordinary Meaning; Thus, Office's Arguments are Untenable

Applicant is confused as to how the Office can allege that a void (14b) formed between a flap (14) and a housing (11) (see FIG. 4 of *Minowa '408*) can protrude from the housing. The plain and ordinary meaning of "protrude" renders the Office's analysis and conclusion untenable. Random House Webster's Unabridged Dictionary, Second Edition, 1998, defines "protrude" as follows: "to cause to project or stick out; to jut out beyond the surrounding surface or context." The Office's Response to Arguments, item 8, page 11, is exemplary. For convenience of analysis the foundation of the Office's response is repeated below.

"... in *Minowa '408*, the housing is defined on the left side by the surface containing platen (12) (see Fig. 4) and since the source is positioned to the left of the platen, it therefore is located in a position protruding from the housing, and since the channel encloses the source, it also is protruding from the housing."

Applicant agrees that the surface containing the platen (12) defines the left side of the housing (11) as depicted in FIG. 4 of *Minowa '408*.

Applicant disagrees, however, with the Office's first conclusion that since the source is positioned to the left of the platen, it is therefore located in a position protruding from the housing. A source to be scanned positioned adjacent to the housing (11) does not project, stick out, or jut out beyond the surrounding surface or context. Consequently, a source positioned to the left of the platen (12) (*i.e.*, in the void (14b)) does not protrude from the housing.

In addition, Applicant disagrees with the Office's second conclusion that since the channel (14b) (*i.e.*, the void between the flap (14) and the housing (11) depicted in FIG. 4 of *Minowa '408*) encloses the source, it also is protruding from the housing. Applicant has shown that a source positioned to the left of platen (12) does not project, stick out, or jut out beyond the surrounding surface or context. Accordingly, a void (14b) between the flap (14) and the housing (11) that encloses the source cannot protrude from the housing (11). For at least this additional reason that *Minowa '408* does not disclose, teach, or suggest Applicant's claimed channel that protrudes from the housing, Applicant's claimed assemblies and methods are allowable over *Minowa '408*.

The Office's mistaken interpretation of the term "protrudes" and the Office's failure to recognize that Applicant has defined "a channel" as an elongated gutter, groove, or furrow (*i.e.*, structure) form the foundation for the Office's incorrect conclusions that *Minowa '408* anticipates Applicant's claimed assemblies and methods and the proposed combinations of *Minowa '408* in view of *Minowa '161*, *Minowa '408* in view of *Minowa '918* render Applicant's claimed assemblies and methods obvious. Thus, claims 1, 2, 4 - 8, 12 - 14, 16 - 26, 28 - 32, 34, 35, and 37 are not anticipated by *Minowa '408*. Claims 10, 11, and 33 are not obvious over *Minowa '408* in view of *Minowa '161*. Claims 3, 9, 15, 27, and 36 are not obvious over *Minowa '408* in view of *Minowa '918*. Moreover, claims 38 and 39 are not obvious over *Minowa '408*.

II. Response to Claim Objection – Claim 16

A. Statement of the Objection

Claim 16 is objected to because of an informality. Specifically, the Office Action alleges: “In Claim 16, lines 4-7 and 8, ‘the means for optically scanning’ lacks proper antecedent basis.”

B. Discussion of the Objection

Applicant has amended claim 16 to recite an optical scanning means. The claim, as amended, contains proper antecedent basis for recited elements. Accordingly, the objection to claim 16 should be withdrawn.

III. Claim Rejections Under 35 U.S.C. §102 – Claims 1, 2, 4 - 8, 12 - 14, 16 - 26, 28 - 32, 34, 35, and 37

A. Statement of the Rejections

Claims 1, 2, 4 - 8, 12 - 14, 16 - 26, 28 - 32, 34, 35, and 37 are rejected under 35 U.S.C. 102(a) as allegedly anticipated by Minowa Japanese Publication No. 2000-209408 (*Minowa* ‘408).

B. Discussion of the Rejections

Applicant’s independent claims 1, 16, 20, 26, and 37 recite structure that is not disclosed, taught, or suggested by *Minowa* ‘408.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See *e.g.*, *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129. (Fed. Cir. 1988.)

Applicant’s claim 1 recites a space-saving scanner assembly comprising “***a channel that protrudes from the housing.***”

In contrast with Applicant’s claimed scanner assembly, FIGs. 4 and 6 of *Minowa* ‘408 appear to show an aperture formed by the source-contact surface of the housing and a flap. An aperture adjacent to a housing does not protrude from the housing. FIG. 4 appears to show that the source rests on a ledge (14c) extending from the flap. A ledge extending from a flap is not a channel. A channel is an elongated gutter, groove, or furrow. Thus, the cited art of record fails to disclose, teach, or suggest at least the

emphasized element of independent claim 1. Accordingly, for at least this reason, *Minowa '408* fails to anticipate Applicant's claim 1. Consequently, the rejection of claim 1 should be withdrawn.

Because independent claim 1 is allowable, its respective dependent claims 2, 4 - 8, and 12 - 14 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or steps of independent claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection of claims 2, 4 - 8, and 12 - 14 also be withdrawn.

Applicant's claim 16 recites a space-saving scanner assembly comprising "means for forming an aperture configured to closely receive a leading edge of a source, such that the source can be spatially arranged with the optical scanning means without adjusting the aperture, ***the source being supported along a second edge of said source along a channel means*** when the source is aligned with the means for optically scanning while in the aperture, . . ."

In contrast with Applicant's claimed scanner assembly, FIGs. 4 and 6 of *Minowa '408* appear to show an aperture configured to receive and support a leading edge of a source when the source is aligned with a means for optically scanning. An aperture that receives and supports a source along a leading edge does not disclose, teach, or suggest ***"the source being supported along a second edge of said source along a channel means."*** Thus, the cited art of record fails to disclose, teach, or suggest at least the emphasized element of independent claim 16. Accordingly, for at least this reason, *Minowa '408* fails to anticipate Applicant's claim 16. Consequently, the rejection of claim 16 should be withdrawn.

Because independent claim 16 is allowable, its respective dependent claims 17 - 19 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 16. *See In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection of claims 17 - 19 also be withdrawn.

Applicant's claim 20 recites a method for saving space on a desktop comprising: "providing an optical scanner having a housing, ***the housing having a substantially vertical source-contact surface with a channel protruding from the housing, the channel having a surface that is substantially parallel to, and opposed from, said***

source-contact surface, the vertical source-contact surface including a transparent platen portion, ***wherein the channel is adjacent to a lower edge of the transparent platen portion and further comprises a second surface substantially orthogonal to the first surface. . .***”

In contrast with Applicant’s claimed scanner assembly, FIGs. 4 and 6 of *Minowa* ‘408 appear to show an aperture formed by the source-contact surface of the housing and a flap. FIG. 4 appears to show that the source rests on a ledge (14c) extending from the flap.

As explained above, an aperture adjacent to a housing does not protrude from the housing. Furthermore, a ledge (14c) that extends from a flap does not protrude from a housing. Moreover, a ledge extending from a flap is not a channel protruding from the housing. A channel is an elongated gutter, groove, or furrow. Thus, the cited art of record fails to disclose, teach, or suggest at least the emphasized limitation of independent claim 20. Accordingly, for at least this reason, *Minowa* ‘408 fails to anticipate Applicant’s claim 20. Consequently, the rejection of claim 20 should be withdrawn.

Because independent claim 20 is allowable, its respective dependent claims 21 - 25 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 20. *See In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection of claims 21 - 25 also be withdrawn.

Applicant’s claim 26 recites a space-saving scanner assembly comprising: ***“a channel protruding from the housing, said channel having a first surface that is substantially parallel to, and opposed from, said source-contact surface and a second surface that is substantially orthogonal to the first surface.”***

In contrast with Applicant’s claimed scanner assembly, FIGs. 4 and 6 of *Minowa* ‘408 appear to show an aperture formed by the source-contact surface of the housing and a flap. FIG. 4 appears to show that the source rests on a ledge (14c) extending from the flap.

An aperture adjacent to a housing does not protrude from the housing. Furthermore, a ledge (14c) that extends from a flap does not protrude from a housing. Moreover, a ledge extending from a flap is not a channel. A channel is an elongated

gutter, groove, or furrow. In addition, Applicant's claimed channel has a "**first surface that is substantially parallel to, and opposed from, said source-contact surface and a second surface that is substantially orthogonal to the first surface.**" *Minowa '408* fails to disclose any structure protruding from a housing. Thus, the cited art of record fails to disclose, teach, or suggest at least the emphasized element of independent claim 26. Accordingly, for at least this reason, *Minowa '408* fails to anticipate Applicant's claim 26. Consequently, the rejection of claim 26 should be withdrawn.

Because independent claim 26 is allowable, its respective dependent claims 28 - 32 and 34 - 36 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 26. *See In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection of claims 28 - 32 and 34 - 36 also be withdrawn.

Applicant's claim 37 recites a method for arranging a source in a scanner comprising: "**inserting a leading edge of the source into an aperture formed by a channel that protrudes from a housing**, the channel having a first surface that is substantially parallel to, and opposed from, a platen of the scanner such that a surface of the source having information thereon that is desired to be imaged by the scanner is adjacent to a sensor arranged in a substantially vertical plane and **such that a second edge of the source is supported by a base surface of said channel**, said base surface extending adjacent to an edge of said platen."

In contrast with Applicant's claimed scanner assembly, FIGs. 4 and 6 of *Minowa '408* appear to show an aperture formed by the source-contact surface of the housing and a flap. FIG. 4 appears to show that the source rests on a ledge (14c) extending from the flap. Thus, *Minowa '408* appears to show an aperture configured to receive and support a leading edge of a source when the source is aligned with a means for optically scanning.

An aperture adjacent to a housing does not protrude from the housing. Furthermore, a ledge (14c) that extends from a flap does not protrude from a housing. Moreover, a ledge extending from a flap is not a channel. Thus, the cited art of record fails to disclose, teach, or suggest at least this limitation of independent claim 37. Accordingly, for at least this reason, *Minowa '408* fails to anticipate Applicant's claim 37. Consequently, the rejection of claim 37 should be withdrawn.

An aperture that receives and supports a source along a leading edge does not disclose, teach, or suggest “*a second edge of the source is supported by a base surface of said channel.*” Thus, the cited art of record fails to disclose, teach, or suggest at least this additional limitation of independent claim 37. Thus, for at least this additional reason *Minowa '408* fails to anticipate Applicant’s claim 37 and the rejection of independent claim 37 should be withdrawn.

IV. Claim Rejections Under 35 U.S.C. §103– Claims 3, 9, 10, 11, 15, 27, 33, 36, 38, and 39

A. Statement of the Rejections

The Office Action indicates that claims 10, 11, and 33 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Minowa '408* in view of *Minowa et al.* (U.S. Patent No. 6,408,161, hereafter *Minowa '161.*)

The Office Action indicates that claims 3, 9, 15, 27, and 36 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Minowa '408* in view of *Minowa* (Japanese Publication No. 2001-053918, hereafter *Minowa '918.*)

The Office Action indicates that claims 38 and 39 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Minowa '408.*

B. Discussion of the Rejections

Applicant’s independent claims 1, 26, and 37 recite structure/limitations that are not disclosed, taught, or suggested by the proposed combination of *Minowa '408* and *Minowa '161.*

To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. *In re Raynes*, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). As stated in MPEP 2143 - Basic Requirements of a *Prima Facie* Case of Obviousness,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant's independent claims 1, 26, and 37 recite claim limitations that are not disclosed, taught, or suggested by the cited references. Accordingly, the proposed combination fails to establish a *prima facie* case for obviousness for failure to teach or suggest all the claim limitations.

Concerning Applicant's claims 10, 11, and 33, Applicant respectfully submits that *Minowa '161* fails to remedy the failure of *Minowa '408* to disclose, teach, or suggest each element in claims 1 and 26, from which claims 10, 11, and 33 depend. Thus, even the proposed combination of *Minowa '408* in view of *Minowa '161* fails to disclose, teach, or suggest at least the elements/limitations emphasized above. Consequently, claims 10, 11, and 33 are allowable and the rejection of claims 10, 11, and 33 should be withdrawn.

Regarding Applicant's claims 3, 9, 15, 27, and 36, Applicant respectfully submits that *Minowa '918* fails to remedy the failure of *Minowa '408* to disclose, teach, or suggest each element in claims 1 and 26, from which claims 3, 9, 15, 27, and 36 depend. Thus, even the proposed combination of *Minowa '408* in view of *Minowa '918* fails to disclose, teach, or suggest at least the elements emphasized above. Consequently, claims 3, 9, 15, 27, and 36 are allowable and the rejection of claims 3, 9, 15, 27, and 36 should be withdrawn.

Regarding Applicant's claims 38 and 39, Applicant respectfully submits that *Minowa '408* fails to disclose, teach, or suggest each element in claim 37. Because independent claim 37 is allowable over *Minowa '408*, as shown above, its respective dependent claims 38 and 39 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 37. *See In re Fine, supra*. Accordingly, the rejection of claims 38 and 39 should also be withdrawn.

V. New Claims 40 - 77

New claims 40 – 77 recite further structure/limitations that are not disclosed, taught, or suggested in *Minowa '408* or in the proposed combinations of *Minowa '408* in view of *Minowa '161* and *Minowa '408* in view of *Minowa '918*. Accordingly, new claims 40 – 77 are allowable over the cited references.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 - 77 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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